

Remarks

Applicants have carefully reviewed the Office Action mailed on March 22, 2005.

Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. With this amendment, claims 1, 13, 15, 23, and 24 are amended. Please cancel claim 12 without prejudice. Claims 1-11 and 13-35 remain pending.

Claims 1-3, 9-12, 15, 20-22, 24, 25, and 30-34 are rejected under 35 U.S.C. §102(e) as being anticipated by Renati et al. in U.S. Patent Publication No. 2004/0044359. Please note that claim 12 is now cancelled and that claim 13 is amended to correct its dependency in light this cancellation. Regarding claims 1-3 and 9-11, claim 1 is amended to recite that at least a portion of the distal region has an increased wall thickness. This amendment essentially incorporates the substance of claim 12 into claim 1.

The Examiner indicated that the substance of claim 12 is shown in Figures 7-8 of Renati et al. Applicants do not see an increased wall thickness in at least a portion of the distal region of the sheath depicted in these figures. Instead, the wall thickness of the sheath appears uniform. Therefore, it does not appear as though Renati et al. anticipates amended claim 1. Because claims 2-3 and 9-11 depend from claim 1, they are also believed to be allowable based on this amendment and because they add significant elements to distinguish them further from the art.

Regarding claims 15 and 20-22, claim 15 is similarly amended to recite that at least a portion of the distal region has an increased wall thickness. For the same reasons set forth above, this amendment is believed to distinguish claim 15 from Renati et al. Because claims 20-22 depend from claim 15, they are also believed to be allowable based

on this amendment and because they add significant elements to distinguish them further from the art.

Regarding claims 24, 25, and 30-34, claim 24 is similarly amended to recite that that at least a portion of the bulbous member has an increased wall thickness. For the same reasons set forth above, this amendment is believed to distinguish claim 24 from Renati et al. Because claims 25 and 30-34 depend from claim 24, they are also believed to be allowable based on this amendment and because they add significant elements to distinguish them further from the art.

Claims 12-14 and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Renati et al. in view of Monroe et al. in U.S. Patent No. 6,322,586. As stated above, claim 12 is now cancelled and its substance is incorporated into amended claim 1. Therefore the rejection of claims 12-14 will be addressed with reference to claims 1 and 13-14. The Examiner indicated that Renati et al. disclose the claimed invention except for a coil and that it would be obvious to modify Renati et al. by adding a coil in view of Monroe et al. The Examiner further indicated on page 3 of the Office Action that “[r]egarding claim 12-13, note figure 16 of the Monroe et al. reference.” While it can be appreciated that Figure 16 of Monroe et al. depicts a tapered distal tip of a catheter assembly, it is not clear from the Examiner’s comments what motivation there is to combine Monroe et al. with Renati et al. in order to render the claimed invention obvious. In fact, we believe that no motivation exists.

MPEP §2143.01 states that “[t]here are three possible sources for a motivation to combine references: the nature of the problem solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” MPEP §2143.01 citing In re

Rouffet, 149 F. 3d 1350, 1357 (Fed. Cir. 1998). The nature of the problem solved in Monroe et al. related to difficulties encountered during the loading of a self-expanding stent onto a catheter. To address this problem, for example, Monroe et al. disclose a catheter tip that improves stent loading. In Renati et al., the problem identified relates to designing a retrieval sheath that more easily passes and already placed stent. Renati et al. solve this problem, for example, with retrieval sheath having a rounded tip. The vast difference in the nature of these problems precludes the nature of the problem as being an adequate source of motivation to combine Monroe et al. with Renati et al. The teachings of the prior art and the knowledge of persons of ordinary skill in the art are also inadequate. Therefore, without any motivation to combine Monroe et al. with Renati et al., a *prima facie* case of obviousness is not properly established. Based on these remarks, Applicants respectfully submit that amended claim 1 as well as claims 13-14 depending therefrom are in condition for allowance.

Regarding claim 35, amended claim 24 similarly recites that at least a portion of the bulbous member has an increased wall thickness. For the reasons set forth above, amended claim 24 is believed to be novel in view of Renati et al. Because there is no motivation to combine Monroe et al. with Renati et al., it is also believed that amended claim 24 is also non-obvious. Because claim 35 depends from claim 24, it is also believed to be patentable for these reasons and because it adds significant elements to distinguish it further from the art.

Claims 4-8, 16-18, 23, and 26-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Renati et al. in view of Johnson et al. in U.S. Patent No. 6,596,011. Regarding claims 4-8, amended claim 1 is believed to be in condition for allowance as

described above. Because claims 4-8 depend from allowable claim 1, they are also allowable based on the amendment to claim 1 and because they add significant elements to distinguish them further from the art.

Regarding claims 16-18, amended claim 15 is believed to be in condition for allowance as described above. Because claims 16-18 depend from allowable claim 16, they are also allowable based on the amendment to claim 15 and because they add significant elements to distinguish them further from the art.

Regarding claim 23, this claim is also amended to recite that at least a portion of the distal region has an increased wall thickness. For the same reasons as those set forth above, this amendment is believed to place claim 23 in condition for allowance.

Regarding claims 26-28, amended claim 24 is believed to be in condition for allowance as described above. Because claims 26-28 depend from allowable claim 24, they are also allowable based on the amendment to claim 24 and because they add significant elements to distinguish them further from the art.

Claims 19 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Renati et al. in view of Johnson et al. as applied to claims 4-8, 16-18, 23, and 26-28 above, and further in view of Auth in U.S. Patent No. 4,646,736. As described above, amended claims 15 and 24 are believed to be in condition for allowance. Because claims 19 and 29 depend from allowable claims 15 and 24, respectively, they are also allowable based on these amendments and because they add significant elements to distinguish them further from the art.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of

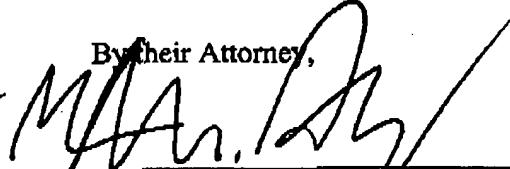
Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

BRIAN J. LOWE ET AL.

By their Attorney,

Date: June 20, 2005


Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050